

REMARKS:

By the present amendment, Applicants amend claims 1, 9, 15, 21, 28, and 31. Claim 27 was canceled by the previous amendment, leaving claims 1-26 and 28-31 pending in the present application.

Claim Rejections under 35 U.S.C. §102(b) – Anderson

The Examiner rejects claims 15-17, 19, 24, and 25 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 3,819,173 ("Anderson").

Independent Claim 15

Claim 15 defines a method of replacing a rejected book on a binding line. The method includes generating a mailing list of recipients having a mailing order, assembling a pre-personalized book on the binding line for each recipient according to the mailing list, rejecting selective pre-personalized books, generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book, and replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order.

Anderson discloses making renewal cards on the binding line for particular magazines. Anderson further discloses making *replacement* renewal cards on the binding line (i.e., replacing cards that are rejected when associated magazines are rejected at a downstream location). When a magazine is rejected, a new magazine and renewal card are reordered to replace the original rejected magazine. The replacement renewal card is exactly the same format as the original that was discarded. The same goes for the replacement magazine, which is exactly the same format as the original discarded magazine. Therefore, Anderson fails to teach or suggest generating an alternate piece on the binding line, the alternate piece being of a different format from a rejected pre-personalized book.

Furthermore, Applicants' claim requires that the alternate piece replaces a rejected pre-personalized book, being positioned to maintain the mailing order on the binding line. The replacement renewal card of Anderson, which is inserted into the replacement magazine, only serves to replace the originally-produced renewal card. The replacement renewal card does not replace the magazine. Nothing replaces the magazine of Anderson except for an *identical-*

format item—a magazine replaces a magazine (and within that magazine, a renewal card replaces a renewal card).

Additionally, the passage of Anderson's text cited in the Examiner's rejection actually illustrates that the mailing order is not maintained. At lines 56-65 of column 1, Anderson says that means are provided for coordinating the downstream delivery of the reordered magazine so that it is properly coordinated with the sorting and mailing operation. Applicants' claim clearly states that the alternate piece is positioned on the binding line to *maintain* the mailing order. Anderson provides specific means for coordinating downstream delivery, clearly illustrating that the mailing order is not maintained, but rather, special operations must be carried out to *restore* the mailing order.

Therefore, Anderson fails to teach or suggest generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book, and replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order.

Claim 15 is allowable for this and other reasons. Claims 16-20 depend from claim 15 and are allowable for at least the same reasons.

Independent Claim 24

Claim 24 defines a binding method including generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature, rejecting selective pre-personalized books, reprinting the pre-personalized signature of one of the rejected pre-personalized books, and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Anderson discloses printing and/or punching a new renewal card for insertion into the replacement magazine. Column 1, paragraph 3 of Anderson suggests that a particular magazine title may include different advertising (e.g., different signatures) for different subscriber groups. However, Anderson fails to teach or suggest a binding method in which a pre-personalized signature is reprinted for a specific individual's magazine after the original magazine with the specific individual's original pre-personalized signature is rejected. On the contrary, magazines, whether new or reordered, are assembled from signatures already in the

inserter (10). Thus, the signatures are not specifically reprinted for a particular subscriber's magazine. The Examiner has not pointed out any particular process step or device capable of carrying out such a step that is disclosed by Anderson.

Therefore, Anderson fails to teach or suggest reprinting the pre-personalized signature of one of the rejected pre-personalized books and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Claim 24 is allowable for this and other reasons. Claims 25 and 26 depend from claim 24 and are allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. §102(b) – Graushar

The Examiner rejects claims 21 and 23 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,347,260 ("Graushar").

Independent Claim 21

Claim 21 defines a binding method including generating a mailing list of recipients, generating a pre-personalized printed product off-line for selected recipients on the mailing list, loading the pre-personalized printed products adjacent a binding line, assembling a book for each recipient including a respective pre-personalized printed product, rejecting selective recipients' books, removing the rejected books from the binding line, and generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.

Graushar discloses a multi-mailer, which combines pre-personalized printed items and items that are not pre-personalized in zip code order. Unacceptable books are rejected and replaced by generic books (column 2, line 66 to column 3, line 4). Personalization on inside pages of select books occurs after the inspection.

Graushar does not teach or suggest generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product. Graushar discloses rejecting a book and replacing it with another book. The replacement book contains signatures and optionally, insert cards like the rejected book. As defined in Applicants' specification, the alternate piece may take one of many media forms,

some of which are printed and some of which are electronic. Applicants' specification gives several examples of printed and electronic media at least at page 5, lines 17-20 and at page 6, lines 7-9. As disclosed by Graushar, the information contained in the generic book may not be exactly the same as the rejected book, but the type of communicative medium (i.e., the signatures and inserts that make up a book) of the replacement is the same as the rejected book. As defined by Applicants' claim 21, the alternate piece must be a different medium than the pre-personalized printed product. As one example of this concept, if the pre-personalized printed product was a magazine page, the alternate piece must be a medium other than a magazine page. The alternate piece could be a different type of printed media or any type of electronic media.

Therefore, Graushar does not teach or suggest assembling a book for each recipient including a respective pre-personalized printed product and generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.

Claim 21 is allowable for this and other reasons. Claims 22 and 23 depend from claim 21 and are allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of Graushar

The Examiner rejects claims 1-3, 5-7, 28, 29, and 31 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Graushar.

Independent Claim 1

Claim 1 defines a binding method including the steps of generating a pre-personalized book on a binding line for a specific individual, rejecting selective pre-personalized books, and generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.

Anderson discloses a method for producing magazines including punching/printing and inserting subscription renewal cards for selected individual subscribers as the subscriber's magazine is being made up. In the event of a fault, the magazine is rejected and reordered. A new card is punched and/or printed for insertion in the magazine. The new magazine must then be coordinated with the other magazines for downstream sorting and mailing operation.

The new magazine and new renewal card are created and assembled to replace the rejected magazine. Thus, the replacement is the same medium as the original (i.e., a magazine). Likewise, if a renewal card is discarded with a defective magazine, a replacement renewal card is exactly the same medium as the original. There is no teaching or suggestion by Anderson to replace one of the rejected magazines with an item of an alternate medium for delivery to the subscriber. It is the intention and sole teaching of Anderson to create a magazine including a renewal card, whether it is an original or a replacement.

As discussed above with respect to claim 21, Graushar discloses a multi-mailer, in which unacceptable books are rejected and replaced by generic books (column 2, line 66 to column 3, line 4). Graushar does not teach or suggest generating an alternate piece, *of an alternate medium compared to the pre-personalized book*, in place of each rejected pre-personalized book to be delivered to the specific individual. Graushar discloses rejecting a book and replacing it with another book (i.e., the very same medium).

Therefore, Anderson and Graushar, alone or in combination, fail to teach or suggest generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.

Claim 1 is allowable for this and other reasons. Claims 2-8 depend from claim 1 and are allowable for at least the same reasons.

Independent Claim 28

Claim 28 defines a binding method including generating a mailing list of recipients, generating a pre-personalized printed product for each recipient, assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece, rejecting selective books, removing the rejected books from respective spaces along the binding line, generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

Anderson discloses reordering a magazine and renewal card that are rejected, rather than generating an alternate pre-personalized piece of a different medium for the subscribers whose magazines are rejected. Anderson discloses reordering the magazine and renewal card

as soon as possible, but makes no teaching or suggestion that the reordered magazine is inserted into the space on the binding line that was previously occupied by the rejected magazine. In fact, Anderson specifically suggests that the reordered magazine is not inserted into the space on the binding line previously occupied by the rejected book, citing at column 1, lines 62-65 that means are provided for coordinating the downstream delivery of the reordered magazine so that it is properly coordinated with the sorting and mailing operation. If the replacement magazine was already in the space previously occupied by the respected rejected magazine, there would be no need for any such coordinating means.

Graushar does not cure the deficiencies of Anderson. Specifically, Graushar discloses rejecting a book and replacing it with another book (i.e., the very same medium). Even though the original book is pre-personalized and the replacement book is generic, the medium remains the same.

Therefore, Anderson and Graushar, alone or in combination, fail to teach or suggest removing rejected books from respective spaces along the binding line, generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

Claim 28 is allowable for this and other reasons. Claims 29 and 30 depend from claim 28 and are allowable for at least the same reasons.

Independent Claim 31

Claim 31 defines a method of replacing a rejected book on a binding line, including generating a mailing list of recipients, assembling a pre-personalized book on the binding line for each recipient, rejecting selected pre-personalized books, replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with a different medium.

The disclosures of both Anderson and Graushar are discussed above. Briefly, Anderson discloses replacing a rejected magazine with an identical magazine (except for errors found in the original), and Graushar discloses replacing a rejected pre-personalized book with a generic

book. Neither Anderson, nor Graushar, nor a combination thereof teaches or suggests replacing a rejected book with a different medium. As taught by both Anderson and Graushar, the medium of the replacement is the same as the original (book for book, magazine for magazine, renewal card for renewal card), and none of the prior art of record, nor combinations thereof suggest replacing a rejected item with a different medium (for example, replacing an article of a particular printed medium with an article of a different printed medium or an electronic medium). Furthermore, neither Anderson, nor Graushar, nor a combination thereof teaches or suggests a method of replacing books on a binding line that includes three separate replacement variations which are: a generic book, a regenerated book identical to what the book should have been, and a different medium.

Therefore, Anderson and Graushar, either alone or in combination, fail to teach or suggest replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with a different medium.

Accordingly, claim 31 is allowable for at least these reasons. Applicants respectfully request withdrawal of the rejection and allowance of claim 31.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of Graushar and Pace

The Examiner rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Graushar and U.S. Patent No. 5,713,605 ("Pace").

Claim 8 depends from claim 1, which is discussed separately above. Applicants' submit that claim 1 is patentable over the prior art of record and that dependent claim 13 is patentable for at least the same reasons.

Therefore, Applicants respectfully request withdrawal of the rejection and allowance of claim 8.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of Pace

The Examiner rejects claim 9-12 and 14 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Pace.

Independent Claim 9

Claim 9 defines a binding method including generating a mailing list of recipients, generating a pre-personalized book for each recipient on a binding line, rejecting one of the pre-personalized books, identifying the recipient of the rejected pre-personalized book, and generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book.

As the Examiner concedes, Anderson fails to disclose that an alternate replacement piece includes a notification to the recipient regarding their pre-personalized book. The disclosure of Pace relates to a compact disc folder for binding into a magazine. Pace does not teach or suggest any particular contents of a compact disc that has anything to do with the status of a pre-personalized book. As far as Pace is concerned, the contents of the compact disc are irrelevant. Furthermore, neither Anderson, nor Pace makes any suggestion of notifying the recipient about a pre-personalized book that has been replaced. The mere fact that compact discs are capable of storing a notification is not sufficient to render Applicants' claim obvious, as only impermissible hindsight could be used to ascertain that the compact disc contents might contain a notification regarding the status of a rejected pre-personalized book.

Therefore, Anderson and Pace, either alone or in combination, fail to teach or suggest generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book.

Claim 9 is allowable for this and other reasons. Claims 10-14 depend from claim 9 and are allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of Graushar and Clark

The Examiner rejects claims 4 and 30 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Graushar and U.S. Patent No. 5,428,423 ("Clark").

Claims 4 and 30 depend from claims 1 and 28, respectively, which are discussed separately above. Applicants' submit that claims 1 and 28 are patentable over the prior art of record and that dependent claims 4 and 30 are patentable for at least the same reasons.

Therefore, Applicants' respectfully request that the rejection of claims 4 and 30 be withdrawn and the claims allowed.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of Pace and Clark

The Examiner rejects claim 13 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Pace and Clark.

Claim 13 depends from claim 9, which is discussed separately above. Applicants' submit that claim 9 is patentable over the prior art of record and that dependent claim 13 is patentable for at least the same reasons.

Therefore, Applicants' respectfully request that the rejection of claim 13 be withdrawn and the claim allowed.

Claim Rejections under 35 U.S.C. §103(a) – Anderson in view of Clark

The Examiner rejects claims 18 and 26 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Clark. Applicants note that the Examiner indicated on page 12 of the Office action that claim 24 was rejected under this combination of the prior art, but that claim 26 was actually addressed.

Claims 18 and 26 depend from claims 15 and 24, respectively, which are discussed separately above. Applicants' submit that claims 15 and 24 are patentable over the prior art of record, and that dependent claims 18 and 26 are patentable for at least the same reasons.

Therefore, Applicants' respectfully request that the rejection to claims 18 and 26 be withdrawn and the claims allowed.

Claim Rejections under 35 U.S.C. §103(a) – Graushar in view of Clark

The Examiner rejects claim 22 under 35 U.S.C. §103(a) as being unpatentable over Graushar in view of Clark.

Claim 22 depends from claim 21, which is discussed in detail above. Applicants submit that claim 21 is patentable over the prior art of record and that dependent claim 22 is patentable for at least the same reasons.

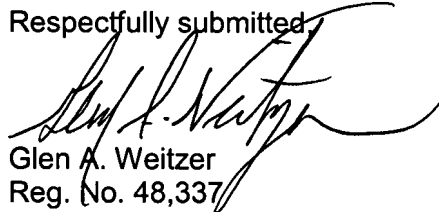
Therefore, Applicants respectfully request that the rejection of claim 22 be withdrawn and the claim allowed.

Conclusion

Applicants amend the present application such that claims 1-26 and 28-30 are pending. By the present Amendment and remarks made herein, Applicants believe all the currently pending claims to be in condition for allowance. Therefore, Applicants respectfully request reconsideration of the rejections and allowance of claims 1-26 and 28-31.

The Examiner is invited to contact the undersigned attorney should the Examiner determine that such action would facilitate the prosecution and allowance of the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Glen A. Weitzer', is written over the typed name and registration number.

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